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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,830	10/04/2001	Richard A. Brandt	0200528.0006	3348

7590

06/07/2004

Salans Hertzfeld Heilbronn Christy & Viener  
620 Fifth Avenue  
New York, NY 10020

EXAMINER
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CHIU, RALEIGH W

ART UNIT	PAPER NUMBER
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3711

17

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/971,830

Applicant(s)

BRANDT, RICHARD A.

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. In view of the Appeal Brief filed on 03 November 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC §§ 102 and 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Melby as applied in the previous Office action.

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Regarding claims 1, 2, 6 and 13, Figure 1 of Melby shows a tennis racquet with the recited head, handle and substantially inflexible parallel longitudinal and transversal sides, wherein the transversal strings are substantially the same length and the longitudinal strings are substantially the same length.

Appellant argues on page 7 of his Brief that the claim 1 recitation of a "means for securing strings to the frame" is not present in Melby and that "each of the strings must by separately and individually connected to the frame to establish vibrational frequencies that are equal".

It is initially noted that the limitation with respect to the vibrational frequencies is not present in the claims. Limitations set forth in the specification cannot be read into the claims for the purpose of avoiding the prior art. Moreover, it does not appear a racquet having separate and individual strings connected to the frame even has a basis in the originally filed specification.

As indicated by appellant, means-plus-function language must be provided the broadest reasonable interpretation in light of the specification. *In re Morris*, 44 USPQ2d 1023. Page 4 of the instant specification explicitly states that the "means of attaching the strings to the frame of the present invention is the same as in conventional rackets". As Melby has been

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established as a prior art racket, the Melby racket is considered to be reasonably interpreted as a conventional racket.

Regarding the claim 1 limitation of the strings running essentially parallel to each other, Figure 1 of Melby clearly shows the longitudinal strings running essentially parallel to each other and the transversal strings running essentially parallel to each other. The fact that the Melby strings may take the form of pairs or loops does not negate the facts that the longitudinal strings do not intersect each other and the transversal strings do not intersect each other.

4. Claims 4, 7, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melby as applied above for the same reasons set forth in the previous Office action.

Regarding claim 4, because Melby intends the racquet to be rectangular and it is well-known in the art that the tensions involved in the stringing process naturally deforms a racquet to a minor degree, it would have been within the capabilities of one of ordinary skill in the art to slightly bow the Melby racquet to offset the inwardly-pressing tendency of the string tension so the string racquet frame would be rectangular.

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Regarding claim 7, the recited dimensions are within the range of tennis racquet known in the art and are not considered to be critically limiting.

Regarding claim 9, the curvature of the rectangular shape of the Melby racquet is zero.

Regarding claim 12, it is old and well-known in the art to adjust the tension of the strings to achieve a particular ball response characteristic.

No specific arguments have been directed against the rejection of the claims.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Melby as previously applied in view of U.S. Patent Numbers 4,212,461 (Cecka et al., hereinafter Cecka), 4,439,908 (McDonald) and 5,037,097 (Svoma et al., hereinafter Svoma).

As previously set forth, because all the strings are of the same length, the vibrational frequencies will be equal. This conclusion is consistent with appellant's own disclosure in his specification. See the first sentence of the bridging paragraph between pages 7-8. Although Melby does not explicitly require that all string segments be tensioned equally, it would have been obvious to one of ordinary skill in the art to tension the Melby strings equally since Cecka, McDonald and Svoma all teach

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that providing a constant string tension is desirable for a tennis racquet as it results in a more uniform string surface and such constancy is an old and well-known concept in the racquet art. See Cecka at column 12, lines 12-16; see McDonald at column 5, lines 51-64; see Svoma at column 6, lines 9-15. The selection of constant string tension would allow the vibrational frequencies of the strings to remain equal.

#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (703) 308-1513.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu  
Primary Examiner  
Technology Center 3700

RWC:dei:feif  
27 May 2004



GREGORY WIDOVICH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700